



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 09/812,828  | 03/21/2001  | Soichi Nemoto        | 1095.1175/JDH             | 1925             |
| 21171   | 7590        | 01/30/2006           | EXAMINER                  |                  |
| STAAS & HALSEY LLP<br>SUITE 700<br>1201 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      | SUBRAMANIAN, NARAYANSWAMY |                  |
|   |             |                      | ART UNIT                  | PAPER NUMBER     |
|   |             |                      | 3624                      |                  |

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                          |                     |  |
|------------------------------|--------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>   | <b>Applicant(s)</b> |  |
|                              | 09/812,828               | NEMOTO ET AL.       |  |
|                              | <b>Examiner</b>          | <b>Art Unit</b>     |  |
|                              | Narayanswamy Subramanian | 3624                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) 6-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/25/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

1. This office action is in response to applicants' communication filed on December 9, 2005. Claims 1-12 are currently pending in the application. Election of group I claims 1-5 and withdrawal of claims 6-12 are acknowledged by the examiner. Applicants are respectfully advised to cancel withdrawn claims 6-12 in response to this office action. Claims 1-5 have been examined. The rejections are stated below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4 and 5 recite the limitations "storing customer information concerning customers" and "identifying a holder of securities after the transaction". It is not clear as to how the "customers" are related to "holder of securities". Also it is not clear if the "transaction" in the second limitation of these claims is "a securities transaction".

Because of the lack of clarity discussed above, it is not clear as to how the first two steps of these claims are related to the last step of these claims. The lack of clarity in these steps makes these claims indeterminate. Claims 2 and 3 are rejected because they depend on claim 1. Appropriate clarification/correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3624

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlan et al (US Patent 6,748,365 B1) in view of Hawkins et al (US Patent 6,247,000 B1).

Claim 1, Quinlan teaches a method for authenticating a purchaser of a product comprising the steps of: storing customer information concerning customers in a storage unit (See Quinlan Column 6 lines 1-4); acquiring transaction information concerning a transaction that has been agreed in an exchange (See Quinlan Column 5 line 64 - Column 6 line 1); and identifying a purchaser of a product after the transaction by comparing the transaction information with the customer information (See Quinlan Column 6 lines 1-7). The purchaser of a product is interpreted to include the holder of the product.

Quinlan does not explicitly teach the step wherein the product is a security.

Hawkins teaches the step wherein the product is a security (See Hawkins Column 21 line 66 - Column 24 line 35)

Both Quinlan and Hawkins are concerned with the problem of settlement after the purchase of a product. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Quinlan to include the teachings of Hawkins. The combination of teachings suggests that buyers of securities would have benefited from dividends and/or rights issued to the purchaser by the issuing entity.

Claim 2, Quinlan does not explicitly teach the steps of associating holder information concerning the holder identified with information concerning a person who

Art Unit: 3624

issues securities and storing associated information in the storage unit; and retrieving the associated information when the person who issues securities requests a retrieval and searching for information concerning a related holder.

Official notice is taken that the steps of associating the holder of securities of a corporation with the corporation and forwarding that information to the corporation when it requests it are old and well known in the art of Corporate Finance. These steps enable the corporation to pay dividends to stockholders (or coupon interest to debt holders) who hold the security on the holder of record date.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Quinlan to include these steps. The combination of teachings suggests that investors of securities would have benefited from the dividends/interest distributed by the issuing entity to investors of record on the record date.

Claim 3, Quinlan does not explicitly teach the steps of determining whether the holder of securities after the transaction has paid an amount by a given deadline and deleting the holder information concerning said holder of securities from the storage unit when it is determined that the amount has not been paid by the given deadline.

Official notice is taken that the steps of deleting the holder information concerning a holder when it is determined that the holder has not paid for the purchase by a given deadline is old and well known in the art. This step allows only holders of securities in good standing to receive the benefits given to the holders.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Quinlan to include this step. The combination of teachings suggests

Art Unit: 3624

that issuers of securities would have benefited from ensuring that the monetary benefits such as dividends are only paid to holders of record in good standing.

Claim 4, Quinlan teaches a computer-readable recording medium storing a program that causes a computer to implement a process for authenticating a purchaser of a product (See Quinlan Column 9 lines 13-17), said program causing the computer to function as: means for storing customer information concerning customers in a storage unit (See Quinlan Column 6 lines 1-4); means for acquiring transaction information concerning a transaction that has been agreed in an exchange (See Quinlan Column 5 line 64 – Column 6 line 1); and means for identifying a purchaser of a product after the transaction by comparing the transaction information with the customer information (See Quinlan Column 6 lines 1-7). The purchaser of a product is interpreted to include the holder of the product and a computer-readable recording medium storing a program that causes a computer to implement the process is inherent in the disclosure of Quinlan.

Quinlan does not explicitly teach the step wherein the product is a security.

Hawkins teaches the step wherein the product is a security (See Hawkins Column 21 line 66 - Column 24 line 35)

Both Quinlan and Hawkins are concerned with the problem of settlement after the purchase of a product. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Quinlan to include the teachings of Hawkins. The combination of teachings suggests that buyers of securities would have benefited from dividends and/or rights issued to the purchaser by the issuing entity.

Claim 5, teaches an authentication apparatus (See Quinlan Column 9 lines 13-17) comprising: means for storing customer information concerning customers in a storage

Art Unit: 3624

unit (See Quinlan Column 6 lines 1-4); means for acquiring transaction information concerning a transaction that has been agreed in an exchange (See Quinlan Column 5 line 64 - Column 6 line 1); and means for identifying a purchaser of a product after the transaction by comparing the transaction information with the customer information (See Quinlan Column 6 lines 1-7). The purchaser of a product is interpreted to include the holder of the product and an authentication apparatus is inherent in the disclosure of Quinlan.

Quinlan does not explicitly teach the step wherein the product is a security.

Hawkins teaches the step wherein the product is a security (See Hawkins Column 21 line 66 - Column 24 line 35)

Both Quinlan and Hawkins are concerned with the problem of settlement after the purchase of a product. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Quinlan to include the teachings of Hawkins. The combination of teachings suggests that buyers of securities would have benefited from dividends and/or rights issued to the purchaser by the issuing entity.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Yamashita et al (US Patent 5,214,269) (May 25, 1993) Method for performing transaction

(b) Burakoff et al (US Patent 6,122,635) (September 19, 2000) Mapping compliance information into useable format

Art Unit: 3624

(c) Kogan et al (US Patent 6,820,069 B1) (November 16, 2004) Rule compliance system and a rule definition language

(d) Kawashima et al (US Patent 6,826,545 B2) (November 30, 2004) Method for settling accounts among a plurality of participants

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
January 18, 2006